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09/414,121

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3622

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/414,121  
Filing Date: October 08, 1999  
Appellant(s): STEEL ET AL.

\_\_\_\_\_  
Brian M. Mancini  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/9/05.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

|             |                 |         |
|-------------|-----------------|---------|
| 6,183,366   | Goldberg et al. | 02-2001 |
| 6,026,375   | Hall et al.     | 02-2000 |
| WO 98/47295 | Titmuss         | 10-1998 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1- 2, 5-8, 11-13, 15-17, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al.(6,183,366 hereinafter Goldberg) in view of Hall (6,026,375 hereinafter Hall).**

In regard to claims 1, 2 Goldberg teaches providing services in a communication network(Abstract).

Providing a plurality of service options to an end user of a communication device (see figures 8A-8B); providing products or services to said end user in response to a subscription to one of the services options (i.e the user receives Internet services once registered with the Internet provider)(col. 29, lines 7-20); providing advertisements to the end user in lieu of receiving compensation for a subscription (col. 29, lines 7-, col. 30, lines 1-19); the advertisements being based on the content that a user is receiving on said device (i.e. the advertisements are presented based on the particular game played by the user)(col. 24, lines 67-, col. 25, lines 1-10) With respect to providing a quota within a predetermined time period; determining whether the advertisements have been delivered; and terminating advertisements upon reaching the quota. Goldberg teaches determining whether the advertisement have been delivered (i.e. assuring that the advertising are indeed presented to the user)(col. 30, lines 2-14) and since the free Internet access to users is subsidized by the download of the advertisements presented to the user (col. 29, lines 7-20) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included of providing

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a quota within a predetermined time period and terminating advertisements upon reaching the quota because such a modification would allow to determine if the client have reached the threshold for the free Internet access.

With respect to the device being a wireless communication device and where the user will be with a predetermined of a predetermined vendor at a future time. Hall teaches processing orders from customers in a mobile environment. Determining the customer arrival time at an identified facility that can satisfy the order within a predetermined window of time coinciding with the customer's estimated time of arrival at the determined facility (col. 3, lines 55-, col. 4, lines 1-5). It would have been obvious to a person of ordinary skill at the time of Applicant's invention to have included the teachings of Hall of advertisements on a wireless communication device and where the user will be with a predetermined of a predetermined vendor at a future time because such a modification would allow **"a service provider to determine the exact location, speed and direction of a mobile customer....and allows the time sequence...while customers are mobile en route to the supplier"** (see col. 2, lines 12-22).

Claim 13 further recites requiring a user to interact with the advertisements to determine whether the advertisement was reviewed. Goldberg teaches the user receiving advertisements in order to get free Internet services (col. 29, lines 7-14) further Goldberg teaches certain reliability features for assuring that the advertising is indeed presented to the user (col. 30, lines 2-14) and since the system of Goldberg is an interactive advertising system for exchanging information (col. 3, lines 66-, col. 4, lines 10-17) then it would have been obvious to a person of ordinary skill in the art at the

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time of Applicant's invention to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure that such an advertisement was reviewed by the user.

With respect to the advertisements being based on a configuration of the wireless Device. Hall teaches that content being based on said configuration of said wireless device (col. 6, lines 66-, col. 7, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the configuration of the device because such a modification would allow the system to only send advertisements that correspond to the device's capabilities.

With respect to claim 5, Hall further teaches providing advertisements when end user preference corresponds with vendor criteria(i.e. based on the customer's identifying criteria and what the service provider offers(vendor) an individualized package and special tailored to meet the individual needs are presented to the customer)(col. 3, lines 55-, col. 4, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements when end user preferences corresponds with vendor criteria because such a modification would allow the system to better target the advertisements.

Claim 6 further recites requiring user interaction to determine whether an advertisement was viewed. Since Goldberg teaches that certain reliability features are included for assuring that the advertisements are presented to the

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user (col. 30, lines 2-5) then it would have been obvious to a person of ordinary skill in the art to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure the advertiser that the customer is entitled to the compensation.

Claims 11 and 19 recite providing advertisements at predetermined times based upon the user device habits. Since, Goldberg teaches maintaining user's preferences information such as length of time played and time played(col. 28, lines 7-17) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a predetermined time which would be convenient to the user to receive advertisements based on the user's prior habits because such a modification would provide the advertisements at a time that would be convenient to the user.

Claim 17 further recites providing advertisements based upon advertisements acceptance. Since Goldberg teaches on col. 26, lines 16-24 that the user's responses to the advertisements are recorded then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing advertisements based on that response because such a modification would help to better target subsequent advertisements.

Claim 22 further recites conveying the determined future location of said wireless communication device to a provider of at least one product or service. Hall teaches

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local facilities 172, 174, 176 receiving the future location and estimated arrival time of the mobile customer in order to allow the facilities to complete the order prior to customer arrival (col. 5, lines 8-28). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Hall of conveying the determined future location of said wireless communication device to a provider of at least one product or service because such a modification would allow the facilities to complete the order prior to customer arrival.

**Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg in view of Hall further in view of Titmuss et al.(WO 98/47295 hereinafter Titmuss).**

With respect to claims 7, 8, 15 and 16, Titmuss teaches that the advertisements are based upon a shopping list of said end user and shopping history of the end user (i.e. based on the customer's prior purchasing behavior and the list of things that the customer might purchase, a list of local facility and what they offer is provided to the end user (pages 14 and 19 ). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements that are based upon a shopping list of said end user and shopping history of the end user because such a modification would allow the system to better target the advertisements.

**(11) *Response to Argument***

With respect to terminating advertisements upon reaching a quota. The Examiner wants to point out that the system of Goldberg on col. 29, lines 21-52



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teaches the user receiving free or reduced Internet services for viewing advertisements. In such a systems as the one described in Goldberg it would make sense and would have been obvious for the advertisements to be terminated when the users have satisfied his or her threshold required to receive the free or discounted service. In addition, the Examiner is citing a reference, Logan et. al. (5,721,827), col. 9, lines 51 to col. 10, lines 1-5 to support the notion that setting a quantity of advertisements that the subscriber is willing to receive (quota) in order to receive the desired level of reduction in the subscription of a service is well known.

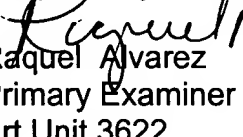
With respect to the user's acknowledgment that the advertisements was viewed. After carefully reviewing Goldberg, the Examiner wants to point out that Goldberg on col. 25, lines 30-48, teaches the advertisers can query the users to obtain feedback from the users regarding the advertisements, such as **"favorable and/or unfavorable responses"** regarding the advertisements viewed, therefore the responses to the advertisements is an acknowledgment that the advertisements have been viewed by the users.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

  
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Primary Examiner  
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R.A.  
May 23, 2005

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